

Applicants respectfully request reconsideration and reexamination of the application, and timely allowance of the pending claims.

II. Provisional Obvious Double Patenting

The Office has maintained its provisional rejection of claims 22-58 under the judicially-created doctrine of obviousness-type double patenting, as being unpatentable over claims 29-61 of co-pending Application No. 09/600,136. (Office Action dated April 11, 2001, page 2.) Applicants respectfully request that these rejections be held in abeyance until all other grounds of rejection are removed, and then pass this case to issue pursuant to M.P.E.P. § 804(I)(B). The Examiner is invited to contact the undersigned so that appropriate measures can be taken to overcome this rejection to pass this case to allowance.

III. Rejections Under 35 U.S.C. § 103

A. *Aaslyng*

The Office maintains its rejection of claims 22-24 and 27-31 under 35 U.S.C. § 103(a) as being unpatentable over WO 97/19998 ("*Aaslyng*") for the reasons of record and as asserted at page 3 of the Office Action. Applicants respectfully traverse this rejection for the reasons of record, and as supplemented below.

The Office admits that *Aaslyng* is deficient because "*Aaslyng* does not teach 3-methyl-4-aminophenol, heterocyclic couplers etc." (Office Action dated April 11, 2001, page 3.) The Office urges, however, "a person of ordinary skill in the art would be motivated to use the prior art of *Aaslyng* to substitute p-aminophenol with 3-methyl-4

amino phenol because they [are] thought to be functionally equivalent by *Aaslyng*.” (Office Action, page 3.) As a basis for its assertion, the Office states that the “patentee teaches them as equivalent coupler[s] listed on page 10 and line 2 in examples to formulate a composition for dyeing hair.” (Office Action dated April 11, 2001, page 3-4.)

To establish a *prima facie* case of obviousness, there must at least be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See M.P.E.P. § 2143. Furthermore, the suggestion or motivation must be found in the prior art, not in Applicants’ disclosure. See *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Aaslyng fails to provide the motivation necessary to support a *prima facie* case of obviousness because the skilled artisan looking to the teachings of *Aaslyng* would find no suggestion to choose Applicants’ composition claimed, for example, in claim 22. *Aaslyng* does not suggest substituting p-aminophenol with at least one of 3-methyl 4-aminophenol and its acid addition salts.

Applicants submit that the Office has not responded to the Applicants argument of record that the Federal Circuit has held that a generic formula does not by itself necessarily render a compound encompassed by that formula obvious. See *In re Baird*, 16 F.3d 380, 382, 29 U.S.P.Q.2d 1550, 1552 (Fed. Cir. 1994). The court in *In re Baird* noted that the disclosed generic formula of diphenol encompassed an abundance of different diphenol species, and the court therefore found no suggestion in the reference to select the particular combination of variables in that formula that would give rise to the

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claimed species in question. *Id.* at 382-83, 29 U.S.P.Q.2d at 1552. Applicants argue that the diphenol genus of *In re Baird* is strikingly analogous to the aminophenol genus of *Aaslyng*. Similarly, *Aaslyng* does not suggest to select the particular combination of variables from that genus that would give rise to 3-methyl 4-aminophenol. The only motivation to use the at least one oxidation base chosen from 3-methyl 4-aminophenol and its acid addition salts recited in claim 22 as a dye is found in Applicants' own specification.

Because *Aaslyng* does not provide the necessary motivation which would lead the skilled artisan to choose the at least one oxidation base recited in claim 22, there is no *prima facie* case of obviousness. Further, these remarks apply with equal force to the rest of claims 23-58. Hence, the rejection should be withdrawn with respect to all of claims 22-58.

B. Aaslyng in view of Audousset

The Office has rejected claims 22, 25-26, 32-58 under 35 U.S.C. § 103(a) as obvious over *Aaslyng* in view of *Audosset et al.* U.S. Patent No. 5,769,903 ("*Audosset*") for the reasons of record, and as supplemented at pages 4-5 of the Office Action. Applicants respectfully traverse this rejection for the reasons that follow.

As discussed above, *Aaslyng* fails to teach or suggest Applicants' claimed combination recited in claim 22. While the Office has applied *Audosset* to cure the deficiencies of *Aaslyng*, *Audosset* also fails to provide the missing motivation requisite for a *prima facie* case of obviousness.

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Audousset is directed to a composition for the oxidation dyeing of keratin fibers, comprising at least one oxidation base, at least one coupler selected from indole couplers, and at least one additional heterocyclic coupler. (*Audousset*, column 2, line 8 to column 3, line 58.) Contrary to the Office's apparent assertion at the last two lines of page 5, *Audousset* teaches nothing at all about the enzymes of the laccase type recited in claim 22.

As a basis for maintaining the rejection, the Office states that "it would have been obvious to substitute 4-amino-3-methylphenol with laccase, modifiers and other conventional ingredients in dyeing compositions." (Office Action, page 4.) The Office has not presented any evidence or sound scientific reasoning of how it would have been obvious for one of ordinary skill in the art to modify *Aaslyng* with a 4-amino-3-methylphenol. Applicants respectfully point out that an extremely immense number of ingredients have been at one time or another been used by one of ordinary skill in the art to make any one of the vast multitude of dyeing compositions known in the art. Applicants submit that choosing any one ingredient, such as 4-amino-3-methylphenol, from the massive number of ingredients known in the art is in itself an indication of the nonobviousness of the claimed composition, and further evidence that there is no motivation to combine the references other than in the applicants' own specification.

Hence, *Aaslyng* provides no motivation for using the at least one oxidation base recited, for example, in claim 22 and *Audousset* provides no motivation to use at least one enzyme of laccase type recited, for example, in claim 22. Other than improper hindsight, there is no reason to combine the two references. Although directed toward

claim 22, these remarks apply with equal force to all of the other claims. Accordingly, Applicants respectfully request that the rejection be withdrawn.

Accordingly, because *Audousset* and *Aaslyng* fail to teach or suggest every element of the Applicant's invention as now claimed, the Office has not established a *prima facie* case of obviousness. Therefore, Applicant respectfully requests withdrawal of this rejection.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this Amendment and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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